

REMARKS

Claims 1 through 5 are pending in this Application. For reasons advocated *infra* Applicants submit that the imposed rejections under 35 U.S.C. §103 are not factually or legally and, hence, solicit reconsideration and withdrawal thereof.

Claims 1 and 3 through 5 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Palmqvist et al. or Lindskog et al. in view of Ishii et al. or Ljungberg.

In the statement of the rejection the Examiner asserted that the recited “roughness is considered inherent to the substrates of Palmqvist or Lindskog et al, since they are honed to produce curvature” (Page 2, second enumerated section). The Examiner then concluded that one having ordinary skill in the art would have been led to provide the alumina layers of Palmqvist et al. or Lindskog et al, with the recited grain sizes in view of Ishii et al. or Ljungberg. This rejection is traversed.

It is, of course, the Examiner’s initial burden to establish a *prima facie* basis to deny patentability to a claimed invention under any statutory provision. *Gilbert & P. Hyatt v. Dudas*, 551 F.3d 1307, 1313 (Fed. Cir. 2008); *In re Glaug*, 283 F.3d 1335 (Fed. Cir. 2002); *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1992; *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984). *See, also, M.P.E.P. §2144 II.A.* In relying upon the doctrine of inherency, the Examiner must provide a factual basis upon which to determine that an allegedly inherent feature is **necessarily** present an applied prior art reference. *Finnegan Corp. v. ITC*, 180 F.3d 1354 (Fed. Cir. 1999); *Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048 (Fed. Cir. 1994); *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Continental Can Co. USA, Olnc. V. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). The mere disclosure of producing

curvature is simply **not** a sufficient **factual basis** upon which to conclude that various claim limitations, in addition to the recited roughness, are inherent, i.e., **necessarily present**, in the alternatively applied primary references.

The claimed insert is designed for and enjoys utility in very high-load cutting. In such rigorous applications, tool failures and heat production result from fracturing due to swarf or swarf powder. The present invention addresses and solves that problem by strategically smoothening areas other than the ridge line, specifically, areas such as the upper part of the breaker part, the bearing surface, and around the fixing hole. Thus, the claimed insert has a combination of features, including the composition of the substrate, a hard phase, a binder phase, and a film thickness, and is smoothened in particular areas. Such an insert, particularly an insert having the above-noted strategically smoothened areas, is neither disclosed nor suggested by any of the applied references. And there is absolutely no factual basis upon which to predicate the determination that the above noted features of the claimed insert are inherent, i.e., **necessarily present**, in the prior art.

Applicants would stress that the above noted features of the claimed insert are functionally significant. For example, as shown in Test Example 2 of the disclosure, a tool in which the vicinity of the edge line is smooth, but one of the upper part of the breaker part, the bearing surface, or around the fixing hole is not smooth, cannot perform high load cutting, as can the claimed invention. Such evidence of **non-obviousness** merits consideration. *In re Soni*, 54 F.3d 746 (Fed. Cir. 1995); *In re Margolis*, 785 F.2d 1029 (Fed. Cir. 1986).

Significantly, none of the applied references discloses or remotely suggests smoothening the upper part of the breaker part, the bearing surface, or around the fixing hole. This being the case, it is apparent that if the applied references are combined as proposed by the Examiner, and

Applicants do not agree that the requisite realistic motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of 1 and 3 through 5 under 35 U.S.C. § 103 for obviousness predicated upon Palmqvist et al. or Lindskog et al. in view of Ishii et al. or Ljungberg, is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 2 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Palmqvist et al. or Lindskog et al. in view of Ishii et al. or Ljungberg, and in further view of Moriguchi et al., Kyocera, or Sumitomo.

This rejection is traversed. Specifically, claim 2 depends from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness predicated upon Palmqvist et al. or Lindskog et al. in view of Ishii et al. or Ljungberg. The additional references to Moriguchi et al., Kyocera, and Sumitomo do not cure the previously argued deficiencies in the attempted combination of Palmqvist et al. or Lindskog et al. in view of Ishii et al. or Ljungberg. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicants, therefore, submit that the imposed rejection of claim 2 under 35 U.S.C. § 103 for obviousness predicated upon Palmqvist et al. or Lindskog et al. in view of Ishii et al. or Ljungberg, and in further view of Moriguchi et al., Kyocera, or Sumitomo is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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Date

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